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OFFICE OF PETITIONS

In re Application of
Guthmann, et al.
Application No. 09/654,149
Filed: 1 September, 2000
Attorney Docket No.: 59156-082

ON PETITION

This is a decision on the petitions:

- filed on 2 July, 2003, to revive under 37 C.F.R. §1.137(a),¹ and in light of the allegations considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181;²

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee required by 37 C.F.R. §1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

² The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

and

- filed via FAX on 18 July, 2002, under 37 C.F.R. §1.137(b)³ to revive the above-identified application as having been abandoned due to unintentional delay.

For the reasons set forth below:

- the petition under 37 C.F.R. §1.137(b) is **GRANTED**;
- the petition considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **DISMISSED**; and
- the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

NOTES: Petitioner Robert E Muir (Reg. No. 23,017) insists (by telephone, through his associate David Chambers (Reg. No. 50,788)), that the record reflect that Mr. Muir authorized filing of the petition under 37 C.F.R. §1.137(b) "under protest" because he believes that his decision to file (what the Examiner determined to be) a paper that was not a proper reply to the 16 October, 2002, final Office action resulted in an abandonment resulting from unavoidable delay.

Petitioner is reminded that the requirements for a response to a final Office action are distinctly different from that for a response to a non-final Office action. And in this connection, Petitioner is directed to the 9 May, 2003, decision the Group Director, wherein she reminded Petitioner that

© When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

³ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

Petitioner “must monitor the status of [after-final replies such as that filed herein], and may not rely on the absence of a response to any reply that has been filed as being an indication that the reply has been entered.”

Petitioner is referred to the regulations at 37 C.F.R. §1.111⁴, §1.113,⁵ and C.F.R. §1.116,⁶ and to the commentary at MPEP §711.03(c).⁷

⁴ The regulations at 37 C.F.R. §1.111 provide:

Sec. 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (Sec. 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See Secs. 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (Sec. 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 Fed. Reg. 29182, May 29, 1981, as amended at 62 Fed. Reg. 53192, Oct. 10, 1997; 65 Fed. Reg. 54672, Sept. 8, 2000]

⁵ The regulations at 37 C.F.R. §1.113 provide:

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 Fed. Reg. 10332, Dec. 22, 1959; 46 Fed. Reg. 29182, May 29, 1981; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 Fed. Reg. 50092, Aug. 16, 2000); para.

(a) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

⁶ The regulations at 37 C.F.R. §1.116 provide:

§1.116 Amendments after final action or appeal.

(a) An amendment after final action or appeal must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§1.113) in an application or in an *ex parte* reexamination filed under §1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under §1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under §1.135, or the reexamination from termination. No amendment can be made in an *inter partes* reexamination proceeding after the right of appeal notice under §1.953 except as provided for in paragraph (d) of this section.

BACKGROUND

A review of the record reveals:

- Petitioner failed to respond properly and timely to the final Office action mailed on 16 October, 2002, with reply due (absent extension of time) on or before Thursday, 16 January, 2003;
- the application went abandoned after midnight 16 January, 2003;
- Notice of Abandonment was mailed on 21 May, 2003;
- Petitioner alleges, and supports with a date-stamped (16 December, 2002) receipt card (see: MPEP §503⁸), that he replied timely to the final Office action;

(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§1.198 and 1.981, or to carry into effect a recommendation under § 1.196 or § 1.977.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

⁷ The commentary at MPEP §711.03(c)(A)(2)(b) provides:

(b) Abandonment for Failure to Reply to a Final Action

A reply under 37 C.F.R. 1.113 to a final action "must include cancellation of, or appeal from the rejection of, each claim so rejected." Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

- (A) a Notice of Appeal and appeal fee;
- (B) an amendment under 37 C.F.R. 1.116 that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance;
- (C) the filing of a request for continued examination (RCE) (accompanied by a submission and the requisite fee) under 37 C.F.R. 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or
- (D) the filing of a continuing application under 37 C.F.R. 1.53(b) (or a CPA under 37 C.F.R. 1.53(d) if the application is a utility or plant application filed before May 29, 2000, or a design application).

When a notice of appeal is the reply filed pursuant to 37 C.F.R. 1.137(a)(1) or 1.137(b)(1), the time period under 37 C.F.R. 1.192 for filing the appeal brief will be set by the Commissioner in the decision granting the petition. An application subject to a final action in which a proposed amendment under 37 C.F.R. 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. From PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection.

⁸ The commentary at MPEP §503 provides in pertinent part:

§503 Application Number and Filing Receipt

37 C.F.R. §1.54. *Parts of application to be filed together: filing receipt.*

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

- the Supervisory Patent Examiner (SPE) found that the 16 December, 2002, amendment failed to place the application in condition for allowance;
- on 17 April, 2003, Petitioner filed a petition under 37 C.F.R. §1.137(a), which was treated as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181;
- in her decision dated 9 May, 2003, the Group Director on denying the petition plainly stated for Petitioner that Petitioner had failed to file a proper reply (see: MPEP §711.03(c), *supra*) to the 16 October final Office action--i.e., a Notice of Appeal, a Request for Continued Examination with submission and fee (under 37 C.F.R. §1.114⁹), or an amendment that *prima*

If a self-addressed postcard is submitted with a patent application, that postcard will be provided with both the receipt date and application number prior to returning it to the addressee. The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. See 37 C.F.R. 1.53(b). The identifying data on the postcard should include:

(A) applicant's name(s);

(B) title of invention;

(C) number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;

(D) whether oath or declaration is included;

(E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and/or provisional application cover sheet); and

(F) amount and manner of paying the fee.

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).

* * *

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application). The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

⁹ The regulations at 37 C.F.R. §1.114 provide:

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee

facie placed the application in condition for allowance;

- on 21 May, 2003, the SPE mailed an Advisory which reminded the Petitioner that the application had gone abandoned because the 16 December, 2002, amendment filed by Petitioner failed to place the application in condition for allowance;
- nonetheless, Petitioner re-advances in the instant petition(s) under 37 C.F.R. §1.137(a) (also considered under 37 C.F.R. §1.181) the very same argument previously rejected by the Group Director--and does so with the same showing as that made before;
- Petitioner, however, does submit with the petition(s) under 37 C.F.R. §1.137(a) (also considered under 37 C.F.R. §1.181) an RCE with submission and fee;
- on 17 July, 2003, a telephone call was placed to Petitioner to raise the aforementioned issues with him;
- on 18 July, 2003, Petitioner filed the petition under 37 C.F.R. §1.137(b), but did so "under protest," as noted above.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
 - (2) Abandonment of the application; or
 - (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
- (b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.
- (c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.
- (d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.
- (e) The provisions of this section do not apply to:
- (1) A provisional application;
 - (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
 - (3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
 - (4) An application for a design patent; or
 - (5) A patent under reexamination

[Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000]

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹⁰

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.¹¹

Delays in responding properly raise the question whether delays are unavoidable.¹² Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).¹³

And the Petitioner must be diligent in attending to the matter.¹⁴ Failure to show diligence does not constitute the care required under Pratt.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹⁵))

Allegations as to the Request to Withdraw
the Holding of Abandonment and
the Petition Alleging Unavoidable Delay

The courts have determined the construct for properly supporting a petition seeking withdrawal

¹⁰ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

¹¹ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

¹² See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

¹³ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹⁴ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

¹⁵ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

of a holding of abandonment.¹⁶

Petitioner has failed to evidence that the Office improperly deemed the instant application abandoned, and thus fails to satisfy the requirements for having the holding of abandonment withdrawn.

A delay is not "unavoidable" when an applicant simply fails to file properly and timely the required reply and so permits the maximum extendable statutory period for reply to expire.¹⁷

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹⁸

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹⁹

Petitioner simply failed to file the proper response to the final Office action--and then allowed both the shortened statutory period and the statutory maximum period to expire.

Such practice clearly does not satisfy the Pratt requirements of diligence in attending to one's most important business affairs.

Therefore, Petitioner fails to satisfy the showing as required under 37 C.F.R. §1.137(a).

Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client²⁰ in the absence of evidence that the attorney/agent has acted to deceive the

¹⁶ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

¹⁷ See MPEP 711.03(c)(III)(C)(2).

¹⁸ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

¹⁹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

²⁰ The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962).

The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

client.²¹

(It long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.²² The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.²³ Such delays are inconsistent with a showing of diligence in the prosecution of one's application,²⁴ and such a course of action would preclude revival of an application under 37 C.F.R. §1.137.²⁵)

Accordingly, Petitioner has failed to establish to the satisfaction of the Commissioner that the delay was "unavoidable" within the meaning of 37 C.F.R. §1.137.²⁶

Allegations as to the Petition

Alleging Unintentional Delay

Petitioner has filed the petition (with fee authorization), made the statement of unintentional delay and filed a reply in the form of an RCE. Petitioner has satisfied the "petition," "fee," "statement" and "reply" requirements of the regulation.

²¹ When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Leonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

²² See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

²³ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

²⁴ The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

²⁵ That an applicant may have been preoccupied with other matters that took precedence over the revival of an abandoned application is not viewed as an adequate justification for delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Rather, the revival of an application that was not intentionally abandoned is the applicant's "most important business." See Ex parte Pratt, 1887 Dec. Comm'r Pats. 31, 32-33 (1887). Specifically, an applicant seeking revival of an abandoned application is expected to file a petition under 37 C.F.R. §1.137 within two to three months of discovering its abandonment. See In re Kokaji, 1 USPQ2d 2005, 2007 (Comm'r Pats. 1986); see also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53161, 1203 Off. Gaz. Pat. Office at 88-89 (response to comment 65).

²⁶ See Application of G, 11 USPQ2d at 1380; In re Application of S, *Id.*

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

Moreover, the circumstances of this application do not demonstrate as of this writing that the delay in filing the first petition was/is within the statutory and regulatory meaning of unavoidable delay--and the instant petition fails to satisfy the "showing" requirement as to relief sought.

Therefore, in the absence of those requirements, the petition herein 37 C.F.R. §1.137(a) must be and hereby is **dismissed**.

The petition herein 37 C.F.R. §1.137(b) is **granted**.

The instant application is being forwarded to Technology Center 3700.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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